

Applicant : Feng-Nien Ko et
Serial No. : 09/522,434
Filed : March 9, 2000
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Attorney's Docket No.: 11544-003001 / 0641-5101US

REMARKS

Applicants have amended claim 1. Support for the amendment can be found in Example 5, in particular, page 9, lines 2-4. No new matter has been introduced.

Claims 1, 3-5, 7-9, and 11-22 are pending. Among them, claims 1 and 11 are currently being examined. Applicants would like to point out that claim 3 has never been withdrawn from consideration, and its examination is requested. See the Request for Continued Examination filed on January 10, 2002.

Claims 1 and 11 are rejected under 35 U.S.C. § 102(b) as being anticipated by any of the following three references, i.e., U.S. Patent No. 4,795,742, JP 04316507A, and JP 61109732A. Applicants traverse the Examiner's grounds for rejection as follows:

U.S. Patent No. 4,795,742

Both claims 1 and 11 are rejected as being anticipated by U.S. Patent No. 4,795,742 ("the '742 patent"). Claim 1, the only independent claim, is discussed first.

Claim 1 covers a composition containing an enriched American ginseng extract obtained by extraction, centrifugation, and filtration with an ultrafiltration membrane with a molecular weight cut off of at least 1,000. Thus, all compounds in the American ginseng extract thus obtained have molecular weights of greater than 1,000. In contrast, the '742 patent does not teach an American ginseng extract in which all of the compounds have molecular weights of greater than 1,000. See discussion Applicants' response mailed May 24, 2002.

According to the Examiner,

"applicant's claims use the open transitional phrase 'comprising.' Due to this open language, applicant's composition can contain additional elements [having molecular weights lower than 1,000]. Since the reference does teach a ginsenoside composition[] that [contains compounds] ha[ving] [] molecular weight[s] greater than 1,000 [in addition to those having lower molecular weights], the reference is still considered to teach the claimed composition." See the Office Action, page 3, lines 3-6.

Applicants have amended claim 1 to clarify that it covers a composition in which all compounds from American ginseng are obtained by the enrichment method recited in the claim. It appears to be the Examiner's position that, given the open transitional phrase "comprising," claim 1 also contains compounds that have molecular weights lower than 1,000. The just-mentioned amendment has made it clear that, in the composition of claim 1, compounds having molecular weights of lower than 1,000, if any, are from a source other than American ginseng. In contrast, the '742 patent describes a composition containing compounds that are from American ginseng and have molecular weights of lower than 1000. Thus, claim 1, as now amended, is clearly not anticipated by the '742 patent. Neither is claim 11, which depends from claim 1.

JP 04316507A

The Examiner rejects claims 1 and 11 as being anticipated by JP 04316507A ("JP '507"). According to the Examiner, "[both] claims only require a component that has a molecular weight that is greater than 1,000[, and t]herefore, the component of JP '507 that is 10,000 MW or greater meets this limitation." See the Office Action, page 3, lines 13-16.

The Examiner's position is tenable if and only if American ginseng extracts do not contain any compounds that have molecular weights between 1,000 and 10,000. As shown in Yoshikawa *et al.* (*Chem. Pharm. Bull.* 46(4): 647-654, 1998 (attached hereto as "Exhibit A")), an American ginseng extract contains many compounds having molecular weights of between 1,000 and 10,000, e.g., 1014 ($C_{52}H_{80}O_{19}$, quinquenoside I; page 648), 1232 ($C_{62}H_{104}O_{24}$, quinquenoside II; page 648), 1122 ($C_{54}H_{90}O_{24}$, quinquenoside IV; page 649), and 1270 ($C_{60}H_{102}O_{28}$, quinquenoside V; page 651). In other words, the composition of claim 1 contains compounds that are from American ginseng and have molecular weights lower than 10,000 and greater than 1,000 (e.g., the just-mentioned four compounds; also see the preceding discussion). In contrast, JP '507 discloses an American ginseng extract in which each compound has a molecular weight of at least 10,000.

In view of the above remarks, Applicants respectfully submit that claim 1, as well as claim 11 dependent from it, is not anticipated by JP '507.

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JP 61109732A

The Examiner relies on JP 61109732A ("JP '732") in the same manner as JP '507 to reject claims 1 and 11. Thus, for the same reasons set forth above, claims 1 and 11 are also not anticipated by JP '732.

CONCLUSION

For the reasons above, Applicants submit that grounds for the rejections asserted by the Examiner have been removed, and that claims 1, 3, and 11 define subject matter that is novel and nonobvious over the prior art.

Attached hereto is a marked-up version of the changes being made by the current amendment.

Please apply any charges to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 12 - 11 - 02

Y. Rocky Tsao

Y. Rocky Tsao, Ph.D., J.D.
Attorney for Applicants
Reg. No. 34,053

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

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Version with markings to show changes made

In the claims:

1. (Amended) A pharmaceutical composition for preventing or treating peptic ulcer, comprising:

- (iii) an American ginseng extract in an amount effective for preventing or treating peptic ulcer; and
- (iv) a pharmaceutically acceptable carrier;

wherein said American ginseng extract constitutes the sole source of compounds from American ginseng, and is extracted with a solvent, centrifuged, and filtered through an ultrafiltration membrane with molecular weight cut off at least 1,000 to give a retentate, and the retentate being concentrated to give the American ginseng extract.